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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/534,995	03/27/2000	Satoru Nishimura	0213-1431-0	4205

7590

05/08/2003

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EXAMINER

EPDS, JANET L

ART UNIT PAPER NUMBER

1635

DATE MAILED: 05/08/2003

22

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/534,995.

Applicant(s)

NISHIMURA ET AL.

Examiner

Janet L. Epps-Ford

Art Unit

1635

--Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 24 April 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

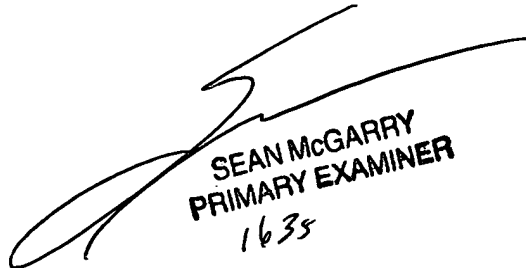
The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 2 and 8 for the reasons of record.Claim(s) objected to: 13 for the reasons of record.Claim(s) rejected: 3-6, 9-12, 14-17, and 23-44 remain rejected for the reasons of record.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: See Continuation Sheet

Continuation of 10. Other: Applicant's amendment defines the stringent conditions for hybridization, however it remains that the claims are limited to a DNA that has 90% homology with the nucleotide sequence shown in SEQ ID NO: 1, 3, or 5, and wherein the DNA encodes a protein having choline monooxygenase activity. However, as stated in the prior Office Action, the specification as filed does not provide a specific structural description of the full scope of nucleotide sequences encompassed by the claimed invention, particularly wherein the nucleic acid sequence hybridizes under stringent conditions, i.e. DNAs having 90% homology or more to the sequences according to SEQ ID NO: 1, 3, 5, or 16, and still encode a protein that maintains either signal peptide activity or CMO activity. Moreover, the specification as filed does not provide sufficient guidance and/or instruction that would unambiguously direct one of skill in the art to those specific nucleotide sequences which are necessary and specific for encoding the amino acid sequences that are responsible for producing choline monooxygenase activity in a protein.



SEAN MCGARRY
PRIMARY EXAMINER
1635